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MARK S. NOWOTARSKI 30 GLEN TERRACE STAMFORD, CT 06906				
EXAMINER				
KINES, ROBERT D				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/601,118

Applicant(s)

ROBERTSON ET AL.

Examiner

R. DAVID RINES

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-39 and 44-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-39 and 44-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

[1] This communication is in response to the amendment/Request for Continued Examination (RCE) filed 2 August 2008. It is noted that this application is a continuation-in-part (CIP) of United States Patent Application #09/452,126 filed 1 December 1999. The Information Disclosure Statement (IDS) filed 24 July 2007 has been entered and considered. Claims 1-36, 40-43, and 47 have been cancelled. Claims 37 and 46 have been amended. Claims 37-39 and 44-46 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 37-39 and 44-46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 37 recites step a. "providing to said prospective insured a set of four or more target questions" Subsequently, claim 37 recites a series of method steps directed to the development of the "four or more" target questions, indicating that the four or more questions must "increase the multiple correlation be statistically significant to at least the 5% level of confidence", as recited in step (g) of claim 37. Examiner has reviewed the Specification as originally filed and can find reference to only four questions which the "level of confidence" criteria. Accordingly, Examiner submits that there is insufficient evidence that, at the time the invention was made, Applicant was in possession of a method in which greater than four questions met the 5% level of confidence criteria.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

Claims 37-39 and 44-46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Under the statute, the claimed invention must fall into one of the four recognized statutory classes of invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter. The latter three categories define "things" or "products" while a process consists of a series of steps or acts to be performed. For purposes of determining whether a process is eligible for patent under 35 U.S.C. 101, a process has been given specialized, limited meaning by the courts.

Under the guidance of Supreme Court precedent and recent Federal Circuit decisions, in order for a process to be considered eligible for patent under 35 U.S.C. 101, the process must (1) be tied to another statutory class or (2) transform underlying subject matter to a different state or thing. If neither of these requirements is met by the claim, the process is not a patent eligible process under 35 U.S.C. 101 and is accordingly rejected as being directed to non-statutory subject matter.

Claim 37 recites a series of method steps directed to the defining of target survey questions. The method steps presented in the body of the claim fail to positively recite the use of a machine, article of manufacture, or a composition of matter in achieving the desired result. As presently constructed, the recited method steps can be accomplished purely by mental processing and are therefore not specifically enabled by another recognized statutory class of invention.

Claims 38-39 and 44-46, when analyzed in the same manner described above with respect to claim 10, also fail to positively recite another statutory class of invention. Therefore, claims 11-18 are also

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[3] Claims 37-39 and 44-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haner (Charles F. Haner, *A Prediction of Automobile Claims by Psychological Methods*, The Journal of Risk and Insurance, vol. 35, no. 1 (Mar. 1968), pp. 49-59) in view of Lajunen (Timo

Lajunen &Heikki Summala, *Drive Experience, Personality, and Skill and Safety-Motive Dimensions in Drivers' Self-Assessments*, Person Individ, Diff. Vol. 19, No.3 (1995), pp. 307-318) and DeTore et al. (United States Patent #4,975,840).

Claims 1-36 have been cancelled.

As per (currently amended) claim 37, Haner discloses a method for risk classification of a prospective insured, said prospective insured applying for automobile insurance, said prospective insured belonging to a demographic group (Haner; page 49, Abstract, paragraphs 1-3 and 7), said method comprising: a. providing to said prospective insured a set of four or more target questions (Haner; page 50, paragraph 4); b. obtaining a set of responses to said set questions from said prospective insured (Haner; page 50, paragraphs 4-5); c. classifying said prospective insured into a risk class based at least in part on said set of responses (Haner; page 49, paragraph 3, page 50, paragraphs 5-7, and page 51, table 1).

Haner further discloses assembly of survey information including f. collecting information from said sample population, said information comprising; i. response to said survey (Haner; page 50, paragraphs 4-8); ii. the number of automobile insurance claims reported by each of said persons in said sample population (Haner; page 51, paragraph 1-3 and Table 1); and iii. conventional classification information for automobile insurance underwriting, said conventional classification information comprising; 1. age ; 2. marital status (Haner; Abstract and page 49, paragraph 1).

As noted above, Haner disclose a personal inventory (i.e., questions/response) directed to the determination of the attitude and personality of the prospective insured (Haner, page 49, paragraphs 5-7 and page 50, paragraphs 1-3), and Haner further discloses well known conventional classification factors including age and marital status (Haner; Abstract and page 49, paragraph 1), Haner fails to disclose the distillation of four or more representative questions from a broad survey of 200 or more individuals. Haner further fails to disclose derivation of four or more questions derived from 50 or more questions administered in the survey.

However, Lajunen discloses providing a questionnaire, wherein a person gives self-assessed skill estimates and safety motives and are asked to assess their own abilities and personality (Lajunen; page 308, paragraphs 1-2 and 5, page 309, paragraphs 1-2).

Lajunen further discloses a technique wherein said set of four or more questions have been devised by a survey method comprising the steps of: e. providing said survey to a sample population of 200 or more people (Lajunen; page 307, paragraph 2); Lajunen further discloses back ground variables (i.e., conventional factors) including 3. years of driving experience; 4. number of miles driven per year (Lajunen; page 309, paragraph 8 and page 314, paragraph 1-2);

Regarding step d. composing a survey of 50 or more questions that tap into personality traits that may affect accident involvement and reporting; Lajunen discloses multiple surveys and tested personality traits and specifically mentions deriving questions from multiple studies including 13/5 choice items from *The Driver Skill Inventory*, 20 items from Hatakka et al., and 9 additional

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measures from Naatanen-Summala (Lajunen; page 308, paragraphs 10-11 and page 309, paragraph 1).

As to step g., Lajunen's correlation method reads on step g. analyzing said information to select said set of four or more questions from among said survey questions such that the survey responses by said sample population to said set of four or more questions significantly increase the multiple correlation between said survey responses and automobile insurance claims reported by said sample population when said conventional classification information is controlled for, said increase in the multiple correlation being significant to at least the 5% level (Lajunen; page 309 paragraphs 2-8, page 310 1-4 and Tables 1-4)

NOTE: *Lajunen employs data from self-reported accidents as opposed to insurance claims. Examiner considers self-reported accidents and insurance claims equivalent data sources with respect to the development of questions and responses to questions and driving tendencies. Both provide a source value for a number of accidents.

NOTE: Lajunen describes extensive analysis of the self-assessments directed to determining those motives and traits most contributory to the driving attributes of the surveyed individuals.

At the time the invention was made, it would have been obvious to include the features of Lajunen within the method taught by Haner with the motivation of measuring skill and safety-motive dimensions in drivers self-assessment of the their driving abilities (Lajunen; Summary on

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page 307) and to properly predict insurance applicant accident susceptibility to accurately determine insurance premiums (Haner; page 49, paragraph 3).

Haner and Lajunen fail to disclose whether the classification is performed "automatically".

However, as is evidenced by DeTore, automatic risk classification for a particular applicant based on data collected including information which may have a bearing on insurability, wherein the classification is performed by an expert module without input from the underwriter (i.e., automatically) (DeTore; col. 5, lines 19-68, col. 10, lines 43-54, col. 14, lines 50 to col. 15, lines 18), is well known in the insurance underwriting art.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the features of DeTore within the method taught collectively by Haner and Lajunen with the motivation of providing an automated system for assessing risk without the aid or intervention of underwriters, thus improving efficiency, quality, and consistency of decisions (DeTore; col. 6, lines 3-10).

As per (currently amended) claim 38, Lajunen discloses a method wherein said set of four or more questions comprises not more than ten questions (Lajunen; page 308, paragraphs 10-11 and page 309, paragraph 1).

As per (currently amended) claim 39, Lajunen discloses a method wherein said set of four or more questions comprises not more than four questions (Lajunen; page 308, paragraphs 10-11 and page 309, paragraph 1).

NOTE: Regarding currently amended claims 38 and 39, Lajunen provides instances of multiple surveys employing 4-20 survey items (i.e., questions) (see claim 37 analysis). Examiner submits that the specific number of questions constitutes a design choice as evidenced by the different statistical measures provided in the Lajunen disclosure.

Claims 40-43 have been cancelled.

As per (newly added) claim 44, Haner discloses a method wherein said method further comprises the steps of: b. obtaining a set of responses to said second set of questions (Haner; page 50, paragraphs 4-5); and c. in said step of classifying said prospective insured into a risk class based at least in part on said set of responses to said four or more questions, also basing said classification of said prospective insured at least in part on and said set of responses to said second questions (Haner; page 49, paragraph 3, page 50, paragraphs 5-7, and page 51, table 1).

While Haner discloses known background elements (i.e., second questions) including age and marital status, Haner fails to indicate background elements (i.e., second questions) including mileage and driving experience.

However, Lajunen discloses step a. providing to said prospective insured a second set of questions related to one or more of said prospective insured age, gender, annual mileage or driving experience (Lajunen; page 309, paragraph 8 and page 310, paragraphs 1-2).

Haner and Lajunen fail to disclose whether the classification is performed "automatically".

However, as is evidenced by DeTore, automatic risk classification for a particular applicant based on data collected including information which may have a bearing on insurability, wherein the classification is performed by an expert module without input from the underwriter (i.e., automatically) (DeTore; col. 5, lines 19-68, col. 10, lines 43-54, col. 14, lines 50 to col. 15, lines 18), is well known in the insurance underwriting art.

As per (newly added) claim 45, Lajunen discloses a method wherein said personality traits comprise: a. impulsivity; b. locus of control; c. self-esteem; d. invulnerability; e. hostility; f. anger; g. trust; h. social desirability; and i. thoroughness in decision making (Lajunen; page 309, paragraphs 2-8 and page 310, paragraphs 1-2, and TABLE 1) NOTE: While Lajunen specifically discloses a number of the personality traits claimed by Applicant, Examiner considers the specific questions and personality traits measure to constitute non-functional data elements as the specific questions or traits measured does not functionally contribute to the determination of relevant personality traits and categorization of individuals into risk classifications).

As per (newly added) claim 46, Lajunen discloses a method wherein at least one of said survey questions is a personal statement with which a person is asked to indicated agreement or disagreement (Lajunen; page 310, paragraphs 1-2).

Claims 47 in cancelled.

Regarding claims 38-39 and 44-46, the obviousness and motivation to combine as discussed with regard to claim 37 above are applicable to claims 38-39 and 44-46 and are herein incorporated by reference.

Response to Remarks/Amendment

Applicant's remarks 2 August 2008 have been fully considered but they are not persuasive and are deemed to have been addressed in the preceding sections of the present Office Action and in the previous Office Action, mailed 5 February 2008, incorporated by reference herein.

Applicant Remarks:

"Lajunen's correlation fails to disclose current step g. because he does not directly correlate the answers of his survey question* to automobile insurance claims. He instead uses the answers to his questions to calculate values of "personality measures" and then attempts to correlate calculated personality measures to self-reported accident rates. not automobile claims"

In response, Examiner would initially direct Applicant's attention to the present claim language, which requires that the survey responses are correlated with the number of claims. The claim as presently constructed does not require the direct correlation of a single response to the claims. If Applicant is referring to the collective responses to the questions then being directly correlated to the claims number, then Examiner submits that the collective responses constitute a "personality measure" analogous to Lajunen's personality measure.

Regarding the correlation between self-reported accidents vs. accident claims, as noted above Examiner views both data sources as provided a data source indicative of driving tendencies and behaviors. At least insofar as correlating survey questions to driving risk and tendencies, both provide a source value measure for how accident prone and individual may be and therefore self-reported accidents and accident claims can be viewed by the Examiner as functional equivalents. NOTE: Lajunen describes extensive analysis of the self-assessments directed to determining those motives and traits most contributory to the driving attributes of the surveyed individuals.

Applicant's remaining remarks are deemed to have been addressed in the preceding sections of the instant Office Action and in the previous Office Actions mailed 2/5/08 and 3/5/07 and incorporated by reference herein.

All of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 8/2/08 amendment, have been fully addressed by the Examiner as

either being fully disclosed or obvious in view of the collective teachings of Haner, Lajunen, and DeTore et al., based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Actions (mailed 3 May 2007 and 2/5/08), and incorporated herein.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. DAVID RINES whose telephone number is (571)272-5585. The examiner can normally be reached on 8:30am - 5:00pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/R. DAVID RINES/

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